

REMARKS/ARGUMENTS

Claims 1-31 remain in the application for further prosecution.

§ 112 Rejection

The Examiner contends that claims 2 and 24 are rejected under 35 U.S.C. § 112, first paragraph, because, the specification does not reasonably provide enablement for video devices, e.g. slots, poker, keno and the like. The Applicant respectfully disagrees. Independent claims 1 and 20, from which claims 2 and 24 depend, recite a "mechanical device" displayed on the gaming machine. The claims further state that a wagering game utilizes the mechanical device. The claim does not state that the wagering game solely uses a mechanical device. The video games listed in claims 2 and 24 simply refer to other parts of the wagering game. As stated in the specification, the mechanical device can be mechanical reels or mechanical dice that are part of the game play. *See* page 8, paragraph 18. According to the specification, the "gaming machine 10 may be any type of wagering gaming machine having displayed mechanical devices....For example, the gaming machine 10 may be a mechanical spinning reel gaming machine (with or without an arm mechanism) configured to play a base slot game and a special feature game using the mechanical reels, or it may be a video gaming machine having mechanical dice configured to play a video wagering game and a special feature game using the mechanical dice, and so on." Id. The specification makes clear that the mechanical device only needs to be utilized in part of the base wagering game and that another device, such as video screens may be utilized in other parts of the base wagering game. It is the Applicant's belief that the specification adequately supports the limitations in claims 2 and 24 that the base wagering game may include various video games.

§ 102 Rejection

Claims 1-3, 5, 6, 8, 11-16, 18-25, 27, 30 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,056,642 (Bennett '642). Independent claim 1 is directed to a "method for changing an appearance of a mechanical device displayed on a gaming machine." The method includes "receiving a wager to play a base wagering game that utilizes a mechanical device" and a "special feature game that utilizes the mechanical device." In response to an indication to play the special feature game being detected, an appearance of the mechanical device is changed.

Bennett '642 is directed to playing a wagering game with mechanical spinning reels. In response to a particular combination being obtained (triple sevens), the background of the combination is altered. Col. 3, ll. 38-48. The player is granted an award, the amount of which depends on the background of the sevens. *Id.* In the described background, if all three sevens have a red background, the player is awarded a jackpot prize. If the three sevens do not all have a red background, the player is awarded a lesser prize. *Id.* The alterable symbols (sevens) are altered during the base game and not a special feature game.

For at least this reason, it is the Applicant's belief that claim 1 and its dependents are allowable over Bennett '642.

Independent claim 13 is also believed to be allowable. Independent claim 13 is directed to a method for changing the appearance of a plurality of reels on a mechanical gaming machine. Claim 13 recites that, in response to detecting an indication to play a bonus game, the color of the reels are changed. Once the bonus game is finished, the reels are returned to their original color. As mentioned above in reference to claim 1, Bennett '642 does not disclose changing the color of

the reel during a bonus game. Also, Bennett '642 discloses changing the color background of certain symbols. Bennett '642 does not disclose, as claim 13 requires, that the color of the reel changes. For at least these reasons, independent claim 13 and its dependents are believed to be allowable over Bennett '642.

Independent claim 20 is directed to a gaming machine that includes an "illumination source adapted to illuminate the displayed mechanical device." The controller causes the illumination source to change an appearance of the displayed mechanical device in response to detecting an indication to play a special feature game. As stated above regarding claims 1 and 13, Bennett '642 does not disclose illuminating the mechanical device during the special feature game. Therefore, for at least this reason, claim 20 and its dependents are believed to be allowable over Bennett '642.

Independent claim 30 is directed to "a method of changing an appearance of a mechanical device displayed on a gaming machine." A base game outcome is displayed with the mechanical device, and in response to detecting an indication to play a special feature game, the appearance of the mechanical device is changed. As stated repeatedly above, Bennett '642 does not disclose changing the appearance of the mechanical device to play a special feature game. Therefore, for at least this reason, claim 30 and its dependent claim are believed to be allowable over Bennett '642.

§ 103 Rejection

Claims 4 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett '642 in view of U.S. Publication No. 2002/0025845 to Cannon ("Cannon"). Claims 4 and 26 are each dependent on claims that include the limitation that the appearance of the

mechanical device is changed in response to a special feature game being played. As stated previously, Bennett '642 does not disclose such a feature. Neither does Cannon. Cannon discloses the method for funding a progressive game via additional wagers. Cannon does not disclose changing the appearance of the mechanical device during a special feature game.

In order for a claim to be obvious, the combined prior art references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974). If an independent claim is nonobvious, then any claim depending from that independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Because a limitation of independent claims 1 and 20, that the appearance of the mechanical device changes during a special feature game, is not disclosed in either reference, or in a combination of the references, then, for at least this reason, dependent claims 4 and 26 are also nonobvious.

Claims 7 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett '642 in view of U.S. Publication No. 2004/0229678 to Onuki et al. ("Onuki"). Dependent claims 7 and 17 depend from independent claims 1 and 13, respectively, and therefore include the limitation that the appearance of the mechanical device is altered during the special feature game. Onuki discloses a gaming machine having mechanical reels and an electroluminescence (EL) display panel 80. The EL display panel 80 may be used for displaying the player's wagering information and also for displaying altered versions of the reel symbols during spinning. The EL display panel 80 does not alter the image of the symbols on the mechanical reels in response to a special feature game being initiated. Therefore, neither Bennett '642 nor Onuki, alone or in combination, disclose all of the limitations of claims 1 and 13. For at least

these reasons, the dependent claims 7 and 17 are believed to be allowable over the combination of Bennett '642 and Onuki.

Claims 9, 10, 28, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett '642. Claims 9, 10, 28, and 29 depend from either claim 1 or claim 20. As stated previously, Bennett '642 does not disclose all of the limitations of claims 1 and 20. Specifically, Bennett '642 does not disclose altering the appearance of the mechanical device in response to a special feature game being initiated. The Examiner has not cited to any reason or support as to why such a modification of Bennett '642 would have obvious to one of ordinary skill in the art. Because a *prima facie* case of obviousness has not been established, dependent claims 9, 10, 28, and 29, which include the limitations of the independent claims from which they depend, are believed to be non-obvious over Bennett '642.

Conclusion

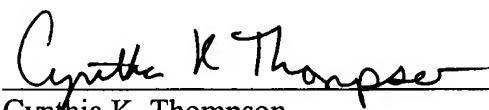
It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

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If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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